



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,493	02/14/2001	Farooq Anjum	APP 1378-US	6341

9941 7590 08/30/2004

TELCORDIA TECHNOLOGIES, INC.
ONE TELCORDIA DRIVE 5G116
PISCATAWAY, NJ 08854-4157

EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
----------	--------------

2126

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,493

Applicant(s)

ANJUM ET AL.

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

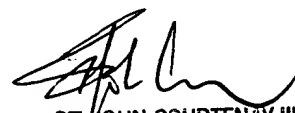
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5-19-03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


ST. JOHN COURTENAY III
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5+6

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Mathis** (U.S. Patent 6,269,254).

As per independent claim 1:

Mathis teaches a method for providing additional services while a communication is being set up or is in progress between a calling and a called party, the method comprising the steps of:

- establishing a communication connection between a calling party and a called party [Mathis teaches radio telephone communication between two parties, col. 3, see discussion beginning line 1; see discussion col. 5, lines 19-56];
- suspending the connection [see `TerminalConnection.leave()` function, col. 4, line 24];
- under control of either the calling or the called party, establishing a separate connection to a resource providing the additional service [see `TerminalConnection.join()` function, col. 4, line 24, used to change call modes in a dual mode (voice and data or voice and fax) system; see col. 5 dual mode discussion, line 60]; and

- providing the resource to the communication between the calling party and the called party [see *TerminalConnection.leave()* function and *TerminalConnection.join()* function discussion, col. 4, line 24; see col. 5 discussion].

As per dependent claims 2 & 3:

Mathis teaches the step of providing comprises providing the resource to a control platform and under control of the control platform, making the service available to either the calling or called party and the control platform includes a call model includes sender and receiver "consult states" and "suspend" states [see *TerminalConnection.leave()* function and *TerminalConnection.join()* function discussion, col. 4, line 24].

As per independent claim 4:

Mathis teaches a system for activating additional services from one or more independent service providers while a telephone communication is being established or is already in progress between a calling party and a called party, the system comprising:

- a smart user terminal having an application programming interface call model [see "The domain of the JTAPI Provider is simply the mobile station (MS)];
- a session control protocol [col. 7, line 58; see also Internet protocol, col. 10, line 9];
- a call control program and call control platform [see call control functions shown in TABLE 3, col. 9]; and

- means for inserting into the platform service control protocols for one of the additional services from one of the service providers [see common service provider module interface (CSPMI), col. 3, line 25; see Provider function calls shown in col. 4, lines 1-16].

As per dependent claim 5:

Mathis teaches the means includes terminal managers [e.g., see "Terminal Objects" and associated discussion col. 13, lines 66-67; col. 14, lines 4-6].

As per dependent claim 6:

Mathis teaches the call model is a Java Telephone application-programming interface call model [col. 2, lines 18-22; see extended discussion of JTAPI extensions beginning col. 12, line 43; see also col. 3, line 20, col. 4, lines 39 & 42 e.g., JTAPI 1.2 discussion].

As per independent claim 7:

Mathis teaches a service architecture for activating additional services from one or more independent service providers for a telecommunications session while a telephone communication is being established or is already in progress between a calling party and a called party, the architecture including:

- a plurality of terminals [e.g., see "Terminal Objects" and associated discussion col. 13, lines 66-67; col. 14, lines 4-6];
- terminal managers associated with the terminals [see "Terminal Connection objects" discussion, col. 14, lines 6-14]
- a plurality of service providers [col. 10, lines 43-51; see Provider function calls shown in col. 4, lines 1-16], and

- software objects containing call control programs for executing software objects within the terminals or the terminal managers to insert service control protocols from the providers for execution by the terminals or the terminal managers [see Terminal Object and Terminal Connection object discussion, beginning col. 13, line 65, cont'd col. 14; see Provider function calls shown in col. 4, lines 1-16].

As per dependent claim 8:

Mathis teaches the use of software objects comprised of:

- call objects [see "Call object" col. 13, line 42];
- connection objects [see "Connection object" col. 13, line 56];
- address objects [see "Address Object" col. 13, line 50];
- terminal connection objects, as claimed [see "Terminal Connection objects" and associated discussion col. 14, line 7].

Objection to the drawings

Fig. 1 should be labeled as "Prior Art" with respect to the drawings received May 19, 2003.

Prior Art not relied upon:

Please refer to the references listed on the attached PTO-892 which are not relied upon in the claim rejections detailed above.

Application/Control Number:
09/783,493
Art Unit: 2126

Page 6

How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to St. John Courtenay III, J.D., M.B.A., whose telephone number is 703-308-5217. A voice mail service is also available at this number. The examiner can normally be reached on M - F 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-AI who can be reached on 703-305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All responses sent by U.S. Mail should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Patent Customers advised to FAX communications to the USPTO

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

Effective Oct. 15, 2003, ALL patent application correspondence transmitted by FAX must be directed to the new PTO central FAX number:

**NEW PTO CENTRAL FAX NUMBER:
703-872-9306**

Application/Control Number:
09/783,493
Art Unit: 2126

Page 7

-
- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:

Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

The Manual of Patent Examining Procedure (MPEP) is available online at:
<http://www.uspto.gov/web/offices/pac/mpep/index.html>



**ST. JOHN COURTENAY III
PRIMARY EXAMINER**